

REMARKS

I. Summary of the Examiner's Action

A. Claim Rejections

As set forth in paragraph 2 on page 2 of the September 27 Office Action, claims 4, 9 and 14 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As set forth in paragraph 5 on page 2 of the September 27 Office Action, claims 1 - 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 7,137,126 to Coffman *et al.* (hereinafter "Coffman" or "the Coffman patent").

These rejections are respectfully disagreed with, and traversed below.

II. Applicant's Response – Claim Rejections

A. Rejection of Claims 4, 9 and 14 under 35 U.S.C. § 112, second paragraph

Applicants have amended claims 4, 9 and 14, thereby mooting the rejection of these claims on this basis. As a result, Applicants respectfully request that the rejection of claims 4, 9 and 14 on this basis be withdrawn.

B. Rejection of Claims 1 – 18
under 35 U.S.C. § 102(b)

1. Propriety of a 35 U.S.C. § 102(b) Rejection

Applicants respectfully request that the Examiner set forth a proper statutory basis of rejection. As will be set forth below, a 35 U.S.C. § 102(b) rejection cannot be maintained solely on the Coffman patent.

Claims 1 – 18 were rejected under 35 U.S.C. § 102(b) as being anticipated by Coffman. Applicants respectfully submit that due to its publication date Coffman is not available as a prior art reference under 35 U.S.C. § 102(b). In particular, 35 U.S.C. § 102(b) provides in pertinent part that “a person shall be entitled to a patent unless ... (b) the invention was patented or described in a printed publication in this or a foreign country ... more than one year prior to the date of the application for patent in the United States.” Applicants’ nominal filing date is January 13, 2005, which precedes in time the November 14, 2006 publication date of Coffman. Applicants’ actual filing date is even earlier (July 17, 2002), since the instant application is a national phase of a PCT application filed on July 17, 2002. In any case, the Coffman patent is not available as a prior art reference under 35 U.S.C. § 102(b).

Regarding the availability of Coffman under another provision of the statute, Applicants would prefer not to guess as to what proper basis of rejection the Examiner would advance after it has been brought to her attention that a 35 U.S.C. § 102(b)

rejection based on Coffman is not available. Rather, Applicants would prefer to leave the establishment of a proper rejection to the Examiner.

It is noted that there are several documents identified on the face of the Coffman patent that apparently may form the basis of rejection. However, due to changes in the law, certain of these documents are either not available, or only available as of a later date. Regarding the availability of the WIPO publication resulting from the Coffman parent, Applicants note that the Coffman patent resulted from a continuation of an International Application No. PCT/US99/22927 filed on October 1, 1999. Due to the early filing date (before November 29, 1999) of the parent, the WIPO publication resulting from the Coffman parent (WO 00/20962) should not be accorded the treatment mandated by the current version of 35 U.S.C. § 102(e). Rather, the availability of Coffman and the WIPO publication should be gauged by an earlier version of 35 U.S.C. § 102(e) (prior to the AIPA amendments) as explained at MPEP 2136.03(II)(C). Under provisions set forth in this section of the MPEP, the prior International Application to Coffman (the Coffman parent) is available only under 35 U.S.C. §§ 102(a) or (b) as of its publication date April 13, 2000 as WIPO Publication No. WO 00/20962. WIPO Publication No. WO 00/20962 is not available at all under 35 U.S.C. § 102(e). United States Patent 7,137,126 (the relied-upon reference in the September 27 Office Action) is available under 35 U.S.C. § 102(e) only as of its actual US filing date of July 2, 2001.

Accordingly, under Applicants' understanding of the controlling law, a rejection under 35 U.S.C. § 102(e) based on the Coffman patent can be maintained by the Examiner. As a result, Applicants will respond to the Office Action on this basis.

In view of the foregoing discussion, Applicants respectfully request that the Examiner set forth with particularity her understanding of the applicable law regarding the availability of Coffman; exactly which Coffman-related reference is being relied on, and the date upon which the relied-upon reference became available in the next Office Action.

2. Insufficiency of an Anticipation Rejection Based on Coffman

Applicants respectfully reproduce claim 1 here as a convenience to the Examiner (emphasis added):

1. A method of operating a mobile device, the method comprising:

maintaining a profile of voice user interface capabilities associated

with the device;

storing an application having voice user interface features on the

device or on a server in communication with the device;

examining at least part of the profile; and

using voice user interface features of the application which are
appropriate to the profile and refraining from using
inappropriate features.

Applicants respectfully submit that the emphasized portions of claim 1 simply are not set forth in the Coffman patent. Accordingly, an anticipation rejection based solely on Coffman is insufficient and should be withdrawn.

In particular, the Examiner makes mention of element 215, the so-called “behavior/service manager” from FIG. 2 of Coffman and the management functions thereof (“such management functions include, for example, keeping track of which applications are registered, what the dialog interfaces of the applications, and what is the state of each application”). Notably absent from this discussion is a specific mention of important aspects of Applicants’ invention as set forth above (“examining at least part of the profile; and using voice user interface features which are appropriate to the profile and refraining from using inappropriate features”). The mere mention of managing several voice applications is not enough. It is conceivable that the voice applications in Coffman are accessed and controlled in similar manners, so there may be no need to review profiles to make sure inappropriate features are not being used.

The Examiner seems to admit that the relied-upon portions of Coffman are insufficient when the Examiner mentions generally (“conversational resource

management”), apparently making an inherency argument. If the features of Applicants’ invention are inherent in Coffman, it would be expected that there would at least be a supporting discussion of problems of differing user interface capabilities. In discussing element 215, Coffman states the following at column 15, lines 24 – 28: “The conversational resource manager 215 is responsible for executing all the different functions *needed to adapt the UI to the capabilities and constraints of the device, application and or user preferences.*” This is simply both a different problem and solution from Applicant’s invention. Applicant’s invention does not *adapt the UI to an application*; rather in applicants invention, only features of a voice user interface of an application that are supported by a profile of a voice user interface of a device are used. Whether there are adaptations of inherent voice user interface capabilities of a device is, as a result, simply irrelevant to the subject matter of claim 1.

Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn. Applicants submit that independent claims 6, 11, 16 and 17 are allowable for reasons similar to those set forth above with respect to claim 1. As a result, Applicants request that the rejection of independent claims 6, 11, 16 and 17 be withdrawn as well. Applicants further submit that the dependent claims are allowable as depending from an allowable base claim.

III. Conclusion

The Applicant submits that in light of the foregoing remarks the application is now in condition for allowance. Applicant therefore respectfully requests that the outstanding rejections be withdrawn and that the case be passed to issuance.

Respectfully submitted,

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Date

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